

## **II. REMARKS**

In response to the Office Action mailed 22 September 2004, the Examiner is requested to reconsider the application in view of the Amendment and following remarks.

Respectfully, and generally for the reasons set forth below, the objections and rejections and each ground therefore -- to the extent not rendered moot by the foregoing Amendment -- are traversed. Generally, it is believed that the amendment adds no new matter.

In the Office Action, at page 2, the Examiner notes that the Office Action is responsive to the letter filed December 12, 2001, which is appreciated. Examiner assistance is requested to obtain a PTO response to the Petition for Corrected Filing Date filed 22 April 2002. Note that a Petition to Make Special was filed by Applicant on 15 February 2002, but apparently the Petition was not considered by the PTO. Now that the case is in examination, making the case special seems moot, and thus Applicant requests that the Petition to Make Special be withdrawn without prejudice. In advance, the undersigned expresses appreciation to the Examiner for assisting with these Petition matters.

In paragraphs 1-2 of the Office Action, the Examiner has objected to informalities in the Abstract. In response, the Abstract has been amended.

In paragraphs 3-4 of the Office Action, the Examiner has objected to informalities in the Specification. In response, the Specification has been amended. Applicant appreciates the Examiner's re-numbering of the claims.

In paragraphs 5-9 of the Office Action, the Examiner has rejected claims 11, 24, 37, and 62 pursuant to 35 U.S.C. Sec. 112. The Examiner contends that these claims are indefinite for reasons more precisely articulated in the referenced paragraphs. In response, the claims have been amended.

In paragraphs 10-27 of the Office Action, the Examiner has rejected claims 1-3, 5-11, 14-55, and 57-75 pursuant to 35 U.S.C. Sec. 102. The Examiner contends that these

claims are anticipated by U.S. Patent No. 6,458,060 (Watterson).

In response, reconsideration and further explanation or allowance is respectfully requested. First, it is respectfully submitted that the rejection is defective because that which forms the basis of the rejection has not been shown to be prior art. Watterson is a CIP filed after Applicant's priority date.

Second, Applicant respectfully requests a more detailed explanation of the Sec. 102 rejection (i.e., pursuant to 35 U.S.C. Sec. 132, "the reasons for such rejection... together with such information as may be useful in judging the propriety of continuing prosecution..."). It appears that the Sec. 102 rejection is defective because the cited art does not disclose all claim requirements.

With regard to claim 1, Applicant respectfully requests an Examiner explanation as to how Watterson teaches the claimed

protecting said machine-readable signals as private to the user....

The Examiner states at page 5 of the Office Action that Watterson "discloses that it is possible for a user to exercise on a device... *while a trainer receives data...*" This appears to contradict the above-mentioned claim limitation. Applicant does not see where in Watterson Applicant's above-provided claim limitation is disclosed, and no contention is made in the Office Action regarding this claim requirement.

Similarly, with regard to claim 3, Applicant respectfully requests an Examiner explanation as to how Watterson teaches the claimed steps of

associating the exercise routine with a machine different from said exercise machine and translating the first set of signals...

Applicant does not see where in Watterson these claim limitations are disclosed, and no contention is made in the Office Action regarding these claim requirements. Watterson does mention that, as depicted in FIG. 1, computer 14 may optionally communicate with

translator device 13 that is configured to manipulate signals transmitted and received between computer 14 and treadmill 12. However, Watterson's use of "translator device 13" does not translate data so as to cooperate in connection with the associating the exercise routine with a machine different from said exercise machine as claimed.

All Sec. 102 rejections are premised on the Watterson teaching of the foregoing in the prior art, and accordingly the rejection is defective for the foregoing reasons.

Remaining claims have been rejected pursuant to Sec. 103. The Examiner makes contentions more precisely stated in the Office Action. In response, the rejection is respectfully traversed as defective, for the reasons stated above with regard to the Sec. 102 rejection with a correspondingly more detailed explanation being respectfully requested.

Additionally, and respectfully, Applicant traverses the contention of inherency in Paragraph 14. Pursuant to MPEP Sec. 2112. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic., citing *In re Rijchaert*: To establish inherency, the extrinsic evidence "must make it clear that the missing descriptive matter is necessarily present...."

Additionally, and respectfully, Applicant traverses the contention in Paragraphs 16-17 that the claimed subject matter is "nonfunctional descriptive information." The mere fact that the Examiner contends this to be so does not make it so in fact, and the Examiner has not met his burden of proving this contention in the context of the method steps of the claim as a whole. A further explanation compliant with Sec. 132 is respectfully requested.


With regard to each allegation that certain claim requirements were "known" (see, e.g., Paragraphs 20, 25, etc.) if the contention is maintained, a reference is required along with a proper reason to combine or modify.

As to art made of record but not relied upon, Applicant does not admit or deny that said art is "prior art," but is appreciative of the search, as well as the examination.

Respectfully, the application is believed to be in condition for allowance, and favorable action is requested. If the prosecution of this case can be in any way advanced by a telephone discussion, the Examiner is requested to call the undersigned at (312) 240-0824. If an allowance is not forthcoming, Applicant respectfully requests an interview in an effort to advance the case.

The Commissioner is hereby authorized to charge any fees associated with the above-identified patent application or credit any overcharges to Deposit Account No. 50-0235, and if any extension of time is needed, this shall be deemed a petition therefor. Please direct all communication to the undersigned at the address given below.

Respectfully submitted,



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